

# Interview Summary

Application No.

09/379,167

Applicant(s)

EISEN ET AL.

Examiner

YOUNG

Group Art Unit

3622

All participants (applicant, applicant's representative, PTO personnel):

(1) ERIC STAMBER (SPE)

(3) BRUCE EISEN (APPLICANT)

(2) JASON FAR-HADIAN (APPLICANT'S REP.)

(4) JAMES LUCAS (APPLICANT)

Date of Interview 6/23/03

Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).Exhibit shown or demonstration conducted: ☒ Yes ☐ No. If yes, brief description:

INTERVIEW OUTLINE SUBMITTED BY MR. FAR-HADIAN (ATTACHED)

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: 1 (REPRESENTATIVE)

Identification of prior art discussed:

CAPIEL (US 6,449,634)

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

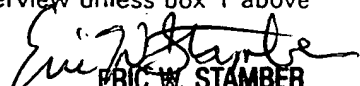
SEE ATTACHED

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☒ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

  
ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

Attachment to the Interview Summary of Paper No. 28.

Mr. Far-hadian and Mr. Eisen began by describing the invention. It is directed to an e-mail that includes a link to a website. The link takes the form of that shown in Fig. 6B, namely <http://www.mystore.com/?XXXX>. The link includes a "unique identifier" (which is seen as "XXXX" in the link of Fig. 6B). This unique ID is associated with the e-mail address that the link is mailed to. The unique ID is also logged at the website when the link is "clicked" and is used to identify the user for tracking purposes at the website. This can be seen in element 703 in Fig. 7A where the unique ID shows up in the tracking details for that user.

This differentiates from the Image Tag of Capiel (the applied prior art) which is not "embedding a unique identifier within a website address" which is included "in an electronic mail message sent to the email recipient" (from claim 1). The Image Tag only identifies what type of file formats (HTML, Java, etc.) the e-mail of the user can process and does not have the claimed unique identifier and does not perform the claimed logging actions.

Mr. Far-hadian said that the applicant was considering either a request for reconsideration or possibly appeal at this point as the application has already been through numerous rejections.

If applicants decide to go the request for reconsideration route, the examiner will have to perform the mandatory updated search. Since prosecution has been lengthy, all effort will be made at identifying more pertinent prior art during the next search, which will include a search of relevant analogous network monitoring areas in Class 709, and at discussing this art in an interview environment in an effort to identify patentable limitations that can be drafted into a claim in order to put the case into condition for allowance.



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# ART UNIT 3622

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## FACSIMILE TRANSMISSION COVER SHEET

Date: 6/24/03.

### TO:

Name: JASON FAR-HADIAN.  
Company: CENTURY IP LAW GROUP.  
Fax No: 949-717-7890.

### FROM:

Name: ERIC STAMBER.  
Telephone: 703-305-8469.

Number of Pages 3 (including this sheet)

IF YOU HAVE NOT RECEIVED ALL PAGES OF THIS TRANSMISSION OR IF ANY OF  
THE PAGES ARE ILLEGIBLE,

PLEASE CONTACT: Eric Stamber 703-305-8469

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Bruce Eisen et al.  
Assignee: User Trends, Inc.  
Title: Electronically Distributing Promotional And Advertising Material  
Based Upon Consumer Internet Usage  
Serial No.: 09/379,167 Filing Date: 08/23/99  
Examiner: John L. Young Group Art Unit: 3622  
Docket No.: M-7729 US

### INTERVIEW OUTLINE

#### **(1) Rejection based on common knowledge:**

On page 8 of the Applicants' response, the Applicant stated "Providing supportive evidence is particularly important here because in every single page of the 30-page Office Action (and with respect to almost every claim), the Examiner has repeatedly relied on the "common knowledge" argument as the basis of rejection, without once offering any evidence to support this basis. Therefore, compliance with the provisions of MPEP §2144.03 and MPEP §2143 for *each instance* of rejection based on "common knowledge" is requested." (emphasis in original).

\* The examiner in his Office Action mailed April 23, 2003 has failed to provide any support, whatsoever, for the allegation of common knowledge.

#### **(2) The cited reference is unrelated to the present invention:**

A. The cited reference collects information different from that collected by the claimed invention. That is, "Capiel is directed to a method and system for remotely determining if a *client computer* has the *software resources* to process certain *file formats* included in an email. In contrast, the present invention is directed to a method of tracking *web pages visited* by an email recipient." (see pg. 8, par. 4) .

B. The cited reference uses a different method, configuration, and system structure to collect the information.

(i) **Image Tag:** The system of Capiel requires including identification information in an image tag (i.e., 1 by 1 pixel gif image) placed in email content forwarded to a user. Including an image tag in the email content is not equivalent to embedding (appending) identification information in a website address (e.g. URL) included in the email, wherein selecting the website address directs the user to a particular website.

"The E-mail sensor server of Capiel does not provide access to any web sites. The E-mail sensor server merely provides a special function which is to monitor calls from the E-mail client. Since the Email sensor server cannot receive information about the web pages or web sites visited by the email recipient, it follows that it cannot function to track 'the email recipient's

movement within the one or more web sites." Therefore, "Capiel cannot be modified to include a process by which the web surfing activities of an email recipient may be monitored and recorded." (see pg. 12, pars. 3, 4; pg. 13, par. 2) This is because the email sensor server of Capiel CANNOT pass the identifying information to any visited web server log files.

(ii) **Email Sensor Server:** "Unlike the present invention, the client computer of Capiel does not forward a 'unique identifier' . . . to a server computer providing access to the one or more web sites. Instead, in the system of Capiel, the unique identifier is forwarded to the E-mail sensor server that 'serves as a middleman information collection point between the vendor systems . . . and the E-mail clients'.<sup>1</sup> The present invention does not require 'a middleman' server for collecting the identifying information." (see pg. 11, par. 3)

The email server of Capiel performs a database function (i.e., recording information about the email address of a user who has an HTML enabled client software for reading emails). The claimed invention, however, causes the identifying information to be stored into a log file of a web server. The claimed invention then later causes the identifying information to be extracted from the server's log file and matched against relevant data to determine visited locations by the user. The only data that the system of Capiel can collect is data that resides on the client side and only if the email reader is HTML enabled; otherwise no data is collected.

### **(3) Capiel cannot be modified in the direction suggested by the Examiner**

The method used in Capiel to collect user identification information is the embedding of the identification information in an image tag included in an email. The method used in the claimed invention to collect a series of information (including identification information and web surfing history) is embedding identification information in a URL included in an email, and passing that information to one or more websites accessible via the URL.

In the claimed invention, the user has the choice of visiting a webpage by selecting the URL. This cannot be done, however, by way of using an image tag because it's simply not within the functional capacity of an image tag to be used in that manner. Thus, the image tag cannot be modified as suggested by the Examiner to provide access to websites. Since, the system of Capiel cannot be used to provide access to any websites by way of the image tag, then it cannot track information about user activity within any websites. Not only there is no motivation to modify Capiel to perform the claimed process of the present invention, it is impossible to do so.

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<sup>1</sup> See col. 3, lns. 17-20 of Capiel.